



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,695	11/04/2003	Yoichiro Yamashita	1131-0491P	5835

2292 7590 03/20/2007
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

LAZORCIK, JASON L

ART UNIT	PAPER NUMBER
----------	--------------

1731

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	03/20/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/20/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/699,695	Applicant(s) YAMASHITA ET AL.	
	Examiner Jason L. Lazorcik	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,11,16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,6,11,16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,6,11,16, and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants original disclosure lacks either explicit or implicit support for the newly presented limitations in Claim 1 and Claim 11 wherein Applicant claims that "the continuous loop pattern extends over almost an entire surface of the wrapping paper, and loops adjacent in the longitudinal direction of the wrapping paper are connected to each other with an overlap".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to Claim 1, Applicant provides for a filter element including "an adhesive region", a cylindrical filter element including "an inner adhesive region", and

“an outer adhesive region” between the filter elements and a forming paper. Each of the adhesive region, inner adhesive region, and outer adhesive region have “a part applied with adhesive”. In Claim 1, Line 29 Applicant provides a limitation drawn to “the adhesive-applied parts”, however it is unclear which, if any, of the aforementioned “a part applied with adhesive” Applicant intends as the antecedent basis. To this end the particular metes and bounds of the instant claim are rendered unclear and indefinite.

Further regarding Claim 1 lines 30-31, Applicant sets forth a limitation drawn to “a longitudinal direction of the wrapping paper as viewed in development of the wrapping paper”. Here the reference to “a longitudinal direction” is dependent upon the particular mode of manufacture and is not necessarily descriptive of a definite structure. Therefore, the limitation set forth in line 33, which provides a constraint upon the loop pattern with particular regard to “the longitudinal direction of the wrapping paper”, renders the particular metes and bounds of the product claim subject to the method of manufacture. Since the structure of the product claimed is contingent upon the mode of manufacture and not upon an inherent property of the structure itself, the particular metes and bounds of the instant claim are rendered unclear and indefinite.

Claim Rejections - 35 USC § 103

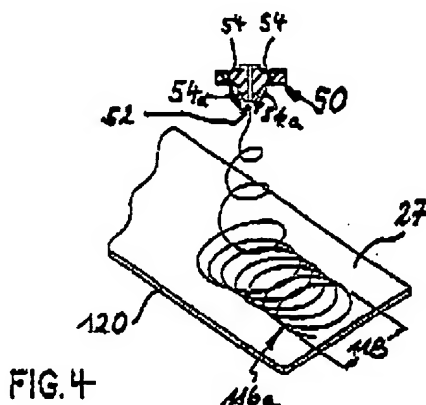
1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1,6,11 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneki et al (US. Pat. No. 6,568,402) in view of Aronoff et al (US. Pat. No. 5,107,866) and Fietkau (US 2002/0023655A1).

Kaneki et al discloses nearly all that is recited in the claim since it teaches a filter assembly having two cylindrical filter elements arranged, in tandem, each of said elements including a filter material, 41, 42 – filter 41 being a plain filter, and filter 42 being a plain filter having activated carbon particles added thereto (corresponding to the claimed “charcoal filter”); wrapping material wound around each filter material element, 43, 44 (corresponding to the claimed “wrapping paper”); and wrapper paper, 12 (corresponding to the claimed “forming paper”), wound around the wrapping materials of the two filter elements to connect the two to each other. While there may be no specific discussion of adhesive provided between the wrapping material and the filter, and between the wrapping material and wrapping paper, it follows that one would have applied said adhesive in such manner as to secure the wrapping to the filter elements in order to secure the elements together, as such is well-known – as evidenced by the Aronoff et al reference – which discloses that the adhesive material can be applied in a spiral manner (corresponding to the claimed “loop pattern”) – if desired, or in a banded pattern, see Fig. 3 (corresponding to the claimed “plurality of adhesive-applied parts arranged at intervals in an axial direction of the filter element”). Further, it would have been obvious to one having ordinary skill in the art at the time of the invention to have also applied the same adhesive between the two wrapping materials in order to further secure same to ensure the filter elements will be sufficiently positioned during smoking.

The reference to Fietkau (US 2002/0023655A1) teaches a particular method of applying an adhesive layer in a spiral geometry. As evidenced by the following excerpt figure 4, the Fietkau process clearly teaches providing a continuous loop pattern over "surface of the wrapping paper" (27) where adjacent loops in the conveyance direction or "longitudinal direction" are "connected to each other with an overlap". The disclosure further teaches that "the width 118 of the layer can be selected and varied in a simple and reliable manner such as by altering the directions and/or velocities of the jets or flows of air which issue from the ports 54."



Fietkau further teaches that the non-linear application of adhesive to one side of the running web 27 provides "a distribution of adhesive on (the) side is much more satisfactory than the heretofore known (compared to) customary applications of straight wide or narrow strips or bands of adhesive". Specifically, the reference teaches that a particular advantage of the spiral overlapping adhesive application is that such a layer of adhesive is "less likely to penetrate through the web".

Neither Kaneki nor Aronoff references explicitly set forth an application of an adhesive presenting overlapping adjacent loops of adhesive in the longitudinal direction.

Art Unit: 1731

However, one of ordinary skill in the art who was aware of the Fietkau teachings would have been fully equipped to tailor both the individual adhesive loop width adjacent adhesive loop overlap to achieve the desired bonding strength while minimizing adhesive penetration of the filter wrapper.

Response to Arguments

Applicant's arguments with respect to claims 1,6,11 and 16-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. United States patent to Boegili et. al. (US 4,281,591) teaches an overlapping pattern of adhesive to a cigarette wrapper which provides point overlap of successive bands of adhesive while not adversely affecting permeability of the wrapper. Although not utilized in the present invention, Applicants new limitation regarding overlapping adhesive bands are also understood to be obvious in light of the instant reference and the previously cited prior art references to Aronoff and Kaneki.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason L. Lazorcik whose telephone number is (571) 272-2217. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00pm.

Art Unit: 1731

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


STEVEN P. GRIFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

JLL